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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,017	12/10/2003	Randall J. Huebner	ACM 347	8612
23581	7590	04/05/2006	EXAMINER	
KOLISCH HARTWELL, P.C. 200 PACIFIC BUILDING 520 SW YAMHILL STREET PORTLAND, OR 97204			COMSTOCK, DAVID C	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,017

Applicant(s)

HUEBNER ET AL.

Examiner

David Comstock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,13,17-19,21-24 and 36-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-45 is/are allowed.
- 6) ☒ Claim(s) 1,4-6,8-11,13,17-19,21,24,46,48-50 and 52 is/are rejected.
- 7) ☒ Claim(s) 3,22,23,36,47 and 51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement of electronic record referred to in the previous action was incorrectly matched to the present application due to an apparent technical error. Accordingly, comments in the record pertaining thereto are to be disregarded. Thus, all submissions by applicant have been duly considered and initialed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6, 8-11, 13, 17-19, 46 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Orsak et al. (6,162,223).

Orsak et al. disclose a dynamic fixation device comprising a distal mounting element 18, a proximal mounting element 17, distal and proximal members 28, and a coupling therebetween. The coupling comprises a flexible wire or rod 75B that provides at least most of the resiliency of the coupling (cf. Figs. 15 and 20). The coupling comprises a plurality of annular spacers 22 (i.e. each revolution) in engagement with each other and disposed on the wire (see Figs. 4, 17 and 18). The coupling includes a

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bracket 73 having restricting rigidizing elements that can be rotated to provide different planes of rotation (i.e. ranges of flexion) by a set screw provided thereon. The plane can be adjusted without affecting the magnitude of the resiliency. The device can be used with structures 56 to restrict translatory motion. Translation can also be adjusted by loosening the set screws on the coupling.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 21, 24, 49, 50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orsak et al. (6,162,223).

Orsak et al. disclose the claimed invention except for explicitly reciting the material as being a superelastic metal such as nickel titanium alloy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Orsak et al. with a known superelastic material such as nickel titanium alloy, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. With regard to claims 24 and 52, it also would have been obvious to provide the device of Orsak et al. with reference markings since the markings merely convey position information about the substrate.

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Where indicia is merely supported by a substrate and only conveys information about the substrate, the functional relationship between the indicia and the substrate is insufficient to distinguish the invention in terms of patentability See *In re Ngai*, 367 F.3d 1336 (C.A.Fed. 2004) and *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983).

Allowable Subject Matter

Claims 37-45 are allowed.

Claims 3, 22, 23, 36, 47 and 51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock
2 April 2006



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER